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KIMBERLY-CLARK WORLDWIDE, INC.
401 NORTH LAKE STREET
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In re Application of:

QIN, JIAN

Serial No.: 10/005,299

Filed: Dec. 4, 2001

Docket: 15,709

Title: ABSORBENT COMPOSITES HAVING
COOLING EFFECT

DECISION ON PETITION

This is a decision on the petition filed on Jun. 24, 2007 by which petitioner requests for a stay in the cancellation of the non-elected claims withdrawn from further consideration by the examiner in the restriction requirement dated Oct. 21, 2003. Claims 4, 5, 8, 22-26, 47, 53-82, 86 and 87 were withdrawn. This petition is considered as if pursuant to 37 CFR 1.144 and 37 CFR 1.181, and no fee is required.

The petition is **GRANTED**.

The record shows that:

- 1) On Oct. 21, 2003, the examiner issued a restriction requirement between nine patentably distinct species. The examiner indicated that there were no generic claims.
- 2) On Mar. 22, 2004, the petitioner filed a response to the restriction requirement by electing species 1, with traverse. Petitioner indicated that claims 2, 3, 6, 17-21, 84 and 85 were readable on the elected species. In addition, petitioner clarified that claims 1, 7-16, 44-46, 83 and 88-97 were generic claims.
- 3) On May 3, 2005, the examiner issued a letter indicating that the response filed on Mar. 22, 2004 was not fully responsive to the restriction requirement because the response did not include a claim listing of all of the claims presented in the case and the proper status identifiers of all of the pending claims.
- 4) On Jun. 3, 2005, the petitioner filed an updated response to the restriction requirement of Oct. 21, 2003. Petitioner indicated that claims 2, 3, 6, 17-21, 84 and 85 were readable on the elected species. In addition, petitioner stated that claims 1, 7, 9-16, 44-46, 83 and 88-97 were generic claims. Petitioner indicated that claims 4, 5, 8, 22-43, 47-82, 86 and 87 were withdrawn.
- 5) On Oct. 5, 2005, the examiner issued a non-final Office action and maintained the restriction requirement. The examiner indicated that claims 4, 5, 8, 22-43, 47-82, 86 and 87 remained withdrawn from further consideration pursuant to 37 CFR 1.142(b).

- 6) On Dec. 22, 2005, the petitioner filed a response to the non-final Office action traversing the prior art rejections.
- 7) On Mar. 9, 2006, the examiner issued a final Office action and maintained the prior art rejections.
- 8) On Sep. 12, 2006, the petitioner filed an after final response.
- 9) On Sep. 26, 2006, the examiner issued a notice of abandonment because the after final response was filed after the expiration of the period set for reply including a total extension time of 3 months.
- 10) On Feb. 28, 2007, after a petition was granted to revive the application from abandonment, the applicant filed a Request for Continued Examination of the application
- 11) On Apr. 11, 2007, the examiner issued a non-final Office action and indicated that claims 4-5, 8, 22-43, 47-82, 86 and 87 remained withdrawn from further consideration. In addition, the examiner stated on page 2 of the non-final Office action that "A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP 821.01".
- 12) On Jun. 24, 2007, the petitioner filed the current petition requesting a stay in the cancellation of the non-elected claims that were withdrawn from further consideration in the restriction requirement.

Discussion and Analysis

A review of the record reveals that the examiner indicated in the non-final Office action dated Apr. 11, 2007 that "A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP 821.01". However, the application was not under final rejection at the time the non-final Office action dated Apr. 11, 2007 was issued. Therefore, petitioner was not required to cancel the non-elected claims or take other appropriate action in response to the non-final Office action.

For petitioner's benefit, according to MPEP 821.04(a)¹, a requirement for restriction should be withdrawn when a generic claim is allowable and any previously withdrawn claim depends from or otherwise requires all the limitations thereof.

In addition, as indicated in the restriction requirement dated Oct. 21, 2003, upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in independent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141.

¹ Where restriction was required between independent or distinct products, or between independent or distinct processes, and all claims directed to an elected invention are allowable, any restriction requirement between the elected invention and any nonelected invention that depends from or otherwise requires all the limitations of an allowable claim should be withdrawn. For example, a requirement for restriction should be withdrawn when a generic claim, linking claim, or subcombination claim is allowable and any previously withdrawn claim depends from or otherwise requires all the limitations thereof. Claims that require all the limitations of an allowable claim will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104. Claims that do not require all the limitations of an allowable claim remain withdrawn from consideration. However, in view of the withdrawal of the restriction requirement, if any claim presented in a continuing application includes all the limitations of a claim that is allowable in the parent application, such claim may be subject to a double patenting rejection over the claims of the parent application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971).

Petitioner's statement on page 1 of the petition that "The Applicant provisionally elected Species 1 including claims 2, 3, 6, 17-21, and 84-85. The Applicant also maintained claims 7-16, 44-46, 48-50, 83 and 88-97 because these claims did not fall within any of the Examiner's species, and in fact are generic to most of such species." is noted. However, there is a discrepancy in what petitioner states as being the generic claims because in the response to restriction requirement dated Jun. 3, 2005, the petitioner stated "That is, Applicant elects claims 2, 3, 6, 17-21, and 84-85 for prosecution in the present application. In addition, Applicant also chooses to pursue claims 1, 7, 9-16, 44-46, 83, and 88-97". The discrepancy lies in the fact that claim 8 was not indicated by petitioner as being a generic claim in the response to restriction requirement. Instead, petitioner indicated that claim 8 was a withdrawn claim (see amendment to the claims included with the response to restriction requirement filed Jun. 3, 2005). The examiner examined on the merits, the claims which petitioner indicated as reading on the elected species. In addition, the examiner examined on the merits, claims 1, 7, 9-16, 44-46, 83 and 88-97 that the petitioner indicated as being generic claims.

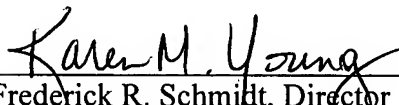
Therefore, for the reasons outlined above, petitioner's request for a stay in the cancellation of the non-elected claims that were withdrawn from further consideration by the examiner in the restriction requirement dated Oct. 21, 2003 is hereby granted.

Conclusion

For the reasons outlined above, petitioner's request for a stay in the cancellation of the non-elected claims is granted.

The application is being forwarded to Supervisory Patent Examiner of Art Unit 3761 for further processing. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181". Any inquiry regarding this decision should be directed to Marc Jimenez, Training Quality Assurance Specialist, at (571) 272-4530.

The petition is GRANTED.

for 

Frederick R. Schmidt, Director
Technology Center 3700